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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

Q137-US3

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name \_\_\_\_\_

Application Number

10/666,860

Filed

September 17, 2003

First Named Inventor

Hisashi Tsukamoto et al.

Art Unit

1745

Examiner

Dah Wei D. Yuan

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,491☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. \_\_\_\_\_

Signature

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Typed or printed name

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Telephone number

07/02/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

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PATENT  
Docket No. Q137-US3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hisashi Tsukamoto et al.

Serial No: 10/666,860

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY  
CONSTRUCTION AND METHOD OF  
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Pre-Appeal Brief Request for Review**

This communication is in response to the Office Action mailed on March 12, 2007 (the Office Action). Pending claims 20-28, 67, and 78-82 are rejected for statutory double patenting over the claims of co-pending U.S. Patent Application serial number 10/666,873 (the cited Office Action). The Applicant submits that a clear legal error has been committed in rejecting claims 20-28, 67, and 78-82 for statutory double patenting.

**REMARKS**

**A. The Pending Claims**

Claim 20 is the only independent claim pending in the current application. Claim 20 is directed to a method of constructing an electric storage battery. The method includes connecting a first end of a first electrode strip to a pin. The method also includes positioning a mandrel on the pin. The method further includes winding the first electrode strip together with a second electrode strip so as to form a spiral roll having at least a portion of the pin within the spiral roll. The spiral roll is formed after positioning the mandrel on the pin.

**Rejection of Claims Under 35 USC §101**

Pending claims 20-28, 67, and 78-82 are rejected for statutory double patenting over the claims of co-pending U.S. Patent Application serial number 10/666,873 (the cited application). This rejection is for statutory double patenting as opposed to nonstatutory double patenting. Accordingly, this rejection requires that the claims are to the same invention.

**Applicant has not been offered the opportunity to elect**

This rejection is double patenting in view of a pending patent application rather than in view of an issued patent. The statutory double patenting rejection is the only rejection left in both applications. The third paragraph of MPEP 804(I)(B)(2) applies to exactly this situation and provides the following:

If a "provisional" statutory double patenting rejection is the only rejection remaining in both applications, the examiner should withdraw that rejection in the application with the earlier filing date and permit that application to issue as a patent. If both applications were filed on the same day, the applicant should be given an opportunity to elect which of the two should be allowed.

Since the immediate application and the cited application were filed on September 17, 2003, the "the applicant should be given an opportunity to elect which of the two should be allowed." The Applicant has not been offered this opportunity in either the immediate application or in the cited application. For this reason alone, the statutory double patenting rejection should be withdrawn and the Applicant should be given the opportunity to elect which Application should be allowed.

**The claims in the immediate application and in the cited application are directed to different inventions.**

A statutory double patenting rejection is not supported unless the claims in the conflicting patent applications are directed to the same invention (MPEP §804.02). However, the claims in the cited application have a different scope from the pending claims.

The Office Action appears to indicate that claim 81 of the present application conflicts with claim 79 of the cited Application. However, claim 81 of the present

application depends from claim 20 which recites “at least a portion of the pin within the spiral roll.” This limitation is not included in claim 79 of the cited application. Further, the prosecution history shows that this language makes claim 81 in the current application patentably distinct from claim 79 in the cited application. For instance, this Application and the cited application are each a Divisional of U.S. Patent Applications serial number 10/167,688 (now U.S. Patent number 6,670,071, the parent case). The Office Action mailed on June 3, 2003 in the parent case states the following:

This application contains claims directed to the following patentably distinct species of the claimed invention.

III-1, Claims 20-28, drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll **having at least a portion of the pin within the spiral roll.**

III-2, Claims 39-42 drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll. (Emphasis added)

The only difference in the descriptions for these “**patentably distinct species**” is the language “having at least a portion of the pin within the spiral roll.” As a result, the June 3, 2003 argues that the language “having at least a portion of the pin within the spiral roll” in claim 20 makes claim 20 patentably distinct from claim 39. Since this language makes claims 20 and 39 patentably distinct in the parent application, this language also makes claim 81 in the current application patentably distinct from claim 79 in the cited application. Since the claims are patentably distinct, these claims are not directed to the same invention and the double patenting rejection should be withdrawn.

**Conclusion**

The Applicant respectfully submits that legal error has been made by rejecting the pending claims for statutory double-patenting. For these reasons, allowance of claims 20-28, 67, and 78-82 is respectfully requested.

Respectfully submitted



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